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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,675	09/27/2005	Ryo Matsuhashi	040696	2624

  

23850	7590	08/02/2007
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EXAMINER	
FRISTOE JR, JOHN K	

  

ART UNIT	PAPER NUMBER
3753	

  

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08/02/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/519,675	MATSUHASHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	John K. Fristoe Jr.	3753	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/7/2007</u>                                                  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 5/7/2007 have been fully considered but they are not persuasive. Applicants stated that a terminal disclaimer has been filed to over the double patenting rejection. However no terminal disclaimer has been filed so the double patenting rejection remains outstanding in the case. Applicants then argue that Schieber and Ogawa can not be modified by using a steel alloy in order to reduce corrosion, the examiner disagrees. Using a specific material for a common part within an assembly requires only ordinary skill and would result in a predictable outcome. Therefore it is obvious to one of ordinary skill in the art to modify a valve assembly by using bolts or nuts of a specific material in order to avoid corrosion of those nuts or bolts. Since any changes to the following prior art rejections were necessitated by Applicants' amendment the instant Office action has been made final.

### ***Information Disclosure Statement***

2. The information disclosure statement filed 5/7/2007 is acknowledged by the examiner.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference

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claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, and 5, respectively, of copending Application No. 10/519,673. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 3, and 5 of Application No. 10/519,673 “anticipate” Application claims 1-3, respectively. Accordingly, Application claims 1-3 are not patentably distinct from Application No. 10/519,673 claims 1, 3, and 5, respectively.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Here Application No. 10/519,673 claim 1 requires:**

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A valve, coupling or like fluid handling part for use in piping and fluid control devices which is composed of a plurality of components, the plurality of components including a specified metal member having a contact surface to be brought into contact with one of the other components, the contact surface having an end exposed on an exterior of the fluid handling part, the fluid handling part being characterized in that the specified metal member is made of an alloy comprising, in % by weight, 0.001 to 0.01% of C, up to 5% of Si, up to 2% of Mn, up to 0.03% of P, up to 100 ppm of S, up to 50 ppm of O, 18 to 25% of Cr, 15 to 25% of Ni, 4.5 to 7.0% of Mo, 0.5 to 3.0% of Cu, 0.1 to 0.3% of N, and the balance substantially Fe and other inevitable impurities, the alloy having a CRI (crevice corrosion resistance index) value in the range of 40  $\leq$  CRI  $\leq$  55, as determined from the expression:

$$\text{CRI} = [\text{Cr}] + 4 * [\text{Mo}] + 30 * [\text{N}]$$

wherein the amounts of alloy components present in combination in the alloy to ensure Crevice corrosion resistance are expressed in % by weight.

**While Application No. 10/519,675 requires:**

A valve, coupling or like fluid handling part for use in piping and fluid control devices which is composed of a plurality of components, the plurality of components including a specified metal member having a surface exposed on an exterior of the fluid handling part, the fluid handling part being characterized in that the metal member is made of an alloy comprising, in % by weight, 0.001 to 0.01% of C, up to 5% of Si, up to 2% of Mn, up to 0.03% of P, up to 100 ppm of S, up to 50 ppm of O, 18 to 25% of Cr, 15 to 25% of Ni, 4.5 to 7.0% of Mo, 0.5 to 3.0% of Cu, 0.1 to 0.3% of N, and the balance substantially Fe and other inevitable impurities.

Thus, it is apparent that the more specific Application No. 10/519,673 claim 1 encompasses Application claim 1. Following the rationale in *In re Goodman* cited in the preceding paragraph, where Applicant has once been granted a patent containing a claim for the specific or narrower invention, Applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer. Note that since Application claim 1 is anticipated by Application No. 10/519,673 claim 1 and since anticipation is the epitome of obviousness, then Application claim 1 is obvious over Application No. 10/519,673 claim 1.

5. Similarly claims 2 and 3 are rejected under the judicially created doctrine of obviousness-type-double patenting as being unpatentable over claims 3 and 5, respectively, for the same reason set forth above.

#### ***Claim Objections***

6. Claim 1 is objected to because of the following informalities: claim 1 first states that the alloy contains elements and their % weights but then S and O are listed in parts per million. In order to circumvent any confusion S and O should be listed in % by weight. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,909,747 (Schieber) in view of U.S. Pat. No. 4,883,554 (Ueda et al.). Schieber discloses a valve comprising a fluid handling part for use in piping comprising a body (22), an actuator (28), a diaphragm (26), and bolts (88) that hold the components together and has a surface exposed to the exterior of the fluid handling part but lacks the bolts being made of a specific metal. Ueda et al. teaches an austenitic stainless steel (table 1, steel compounds encompass Applicants' disclosed alloy) for members in contact with seawater. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the diaphragm valve of Schieber by manufacturing the bolts from the disclosed austenitic steel alloy as taught by Ueda et al. in order to avoid corrosion that may render the bolts inoperable.

9. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 4,630,851 (Ogawa) in view of U.S. Pat. No. 4,883,554 (Ueda et al.). Ogawa discloses a fluid handling part comprising a pipe coupling (figure 1), a cap nut (8) that has a surface exposed to an exterior of the fluid handling part, an externally threaded portion (2), and a tubular coupling member (1) but lacks the cap nut being a specified metal. Ueda et al. teaches an austenitic stainless steel (table 1, steel compounds encompass Applicants' disclosed alloy) for members in contact with seawater. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the pipe coupling of Ogawa by manufacturing the cap nut from the disclosed austenitic steel alloy as taught by Ueda et al. in order to avoid corrosion that may render the cap nut inoperable.

*Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John K. Fristoe Jr. whose telephone number is (571) 272-4926. The examiner can normally be reached on Monday-Friday, 7: 00 a.m-4: 30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric S. Keasel can be reached on (571) 272-4929. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John K. Fristoe Jr./

John K. Fristoe Jr.

Examiner

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JKF



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